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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,959	11/16/2001	Don Roderick Donovan	8628R	6652

27752 7590 10/29/2004

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,959

Applicant(s)

DONOVAN ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 22-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/5/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 22-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 12, 2004.

The traversal is on the ground(s) that the examination of the subject matter recited in the claims of Groups I-II would not place a substantially greater burden on the Examiner.

This is not found persuasive because for purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. In the instant application Group I would be classified in 705/26 and Group II would be classified in 705/14. These inventions have acquired a separate status in the art as shown by their different classification, which would result in the need of a different field of search by the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Page 1 of the specification does not disclose the relationship between the instant application and U.S. Patent Application No. 09/389,933.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

This application has been filed with informal drawings, which are acceptable for examination purposes only. Figures 28-33 and 35-43 contain improper shading that may affect clarity when reproduced.

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Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 1-21. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. The claims do include the use of technology (i.e. "a graphical user interface) in a trivial fashion. The "graphical user interface" is merely used to display data and is not functionally interrelate with the method steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilmott U.S. Patent Number 6,782,307.

Referring to claim 1. Wilmott discloses a method for synthesizing and distributing personal care products in a retail environment, comprising:

- Generating preference data in the retail environment, the preference data being representative of expressed preferences of a consumer with regard to personal care (Wilmott: column 6, lines 16-31);
- In response to the preference data, generating instructions for reproducibly synthesizing a first personal care product in a format perceivable and understandable by humans (Wilmott: column 9, lines 41-64);
- Synthesizing the first personal care product in the retail environment in accordance with the instructions (Wilmott: column 9, lines 41-64); and
- Providing the first personal care product to the consumer before the consumer leaves the retail environment (Wilmott: column 9, lines 41-64).

Referring to claim 2. Wilmott further discloses a method wherein generating the preference data comprises employing a graphical user interface to record responses by the consumer to a series of questions (Wilmott: Fig. X3-B).

Referring to claim 3. Wilmott further discloses a method wherein either of the consumer and a consultant employs the graphical user interface to record the responses (Wilmott: column 2, line 67 to column 3, line 15, "Point-of-sale").

Referring to claim 4. Wilmott further discloses a method wherein the graphical user interface is generated by either of a stand-alone computing device and a networked computing device (Wilmott: column 9, lines 41-64).

Referring to claim 5. Wilmott further discloses a method comprising employing the graphical user interface to retrieve previously generated data corresponding to the consumer (Wilmott: column 3, lines 16-35).

Referring to claim 6. Wilmott further discloses a method wherein the previously generated data comprises at least one of identification data representing the consumer, and commercial behavior data representing previous commercial activity by the consumer (Wilmott: column 3, lines 16-35).

Referring to claim 7. Wilmott further discloses a method wherein generating the instructions comprises any of providing the instructions in a graphical user interface, printing the instructions, and providing an audio representation of the instructions (Wilmott: column 9, lines 41-64).

Referring to claim 8. Wilmott further discloses a method wherein synthesizing the first personal care product comprises manually combining predetermined amounts

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of at least two personal care product components according to the instructions (Wilmott: column 9, lines 41-64).

Referring to claim 9. Wilmott further discloses a method wherein the predetermined amounts are provided via a manually operated dispensing system (Wilmott: column 9, lines 41-64).

Referring to claim 10. Wilmott further discloses a method wherein the predetermined amounts are provided in previously measured increments (Wilmott: Fig. 2 and Fig. 3).

Referring to claim 11. Wilmott further discloses a method wherein providing the first personal care product to the consumer comprises placing the first personal care product in a container, the method further comprising generating customized labeling for the container (Wilmott: column 8, line 59 to column 9, line 30).

Referring to claim 12. Wilmott further discloses a method wherein providing the first personal care product to the consumer comprises providing the first personal care product to the consumer in a sample size container (Wilmott: column 8, line 59 to column 9, line 30).

Referring to claim 13. Wilmott further discloses a method comprising: transmitting the instructions to a manufacturing facility; synthesizing the first personal care product; placing the first personal care product in a second container larger than the sample size container; and sending the second container to either of an address designated by the consumer, and the retail environment (Wilmott: column 8, line 59 to column 9, line 65).

Referring to claim 14. Wilmott further discloses a method comprising storing the instructions for future synthesis of the first personal care product (Wilmott: column 3, lines 16-35).

Referring to claim 15. Wilmott further discloses a method wherein storing the instructions comprises either of electronically storing instruction data representative of the instructions and storing a paper copy of the instructions (Wilmott: column 8, line 59 to column 9, line 65).

Referring to claim 16. Wilmott further discloses a method comprising synthesizing an additional amount of the first personal care product in response to a request from the consumer in accordance with the stored instructions (Wilmott: column 8, line 59 to column 9, line 65).

Referring to claim 17. Wilmott further discloses a method comprising a fragrance, the method further comprising identifying a first fragrance with reference to a first portion of the preference data, and identifying a second fragrance with reference to the first fragrance and a second portion of the preference data (Wilmott: column 14, lines 52-61).

Referring to claim 18. Wilmott further discloses a method wherein the first personal care product comprises a final formulation comprising a plurality of components, the method further comprising combining less than all of the components to synthesize an intermediate formulation, and providing a sample of the intermediate formulation to the consumer (Wilmott: column 9, lines 41-64).

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Referring to claim 19. Wilmott further discloses a method wherein the first personal care product comprises any of a fragrance, a cosmetic product, a skin care product, and a hair care product (Wilmott: abstract).

Even though Wilmott discloses a method according to claim 19 as indicated supra, the Examiner notes, the type of first formulation is not functionally related to the method steps. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 20. Wilmott further discloses a method wherein the final formulation comprises any of body wash, body lotion, hand cream, eye treatment, facial moisturizer, facial cleanser, facial balancer, shampoo, conditioner, body scrub, face mask, and face scrub (Wilmott: abstract).

Even though Wilmott discloses a method according to claim 20 as indicated supra, the Examiner notes, the type of final formulation is not functionally related to the method steps. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 21. Wilmott further discloses a personal care product synthesized according to the method of claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bartholomew et al., U.S. Patent No. 6,779,686, August 24, 2004, discloses a point-of-sale body powder dispensing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to be 'M. L.', written in a cursive style.

MSG

Patent Examiner

October 26, 2004